



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/975,230	10/11/2001	Meroni Bruno	J118-104 US	9595

21706 7590 03/11/2003

NOTARO AND MICHALOS
100 DUTCH HILL ROAD
SUITE 110
ORANGEBURG, NY 10962-2100

EXAMINER

CANTELMO, GREGG

ART UNIT	PAPER NUMBER
----------	--------------

, 1745

DATE MAILED: 03/11/2003

15

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/975,230

Applicant(s)

BRUNO, MERONI

Examiner

Gregg Cantelmo

Art Unit

1745

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 February 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-19 and 22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-19 and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other:

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 11, 2003 has been entered.

Response to Amendment

2. In response to the amendment received December 17, 2002 and entered as per the RCE received February 11, 2003:

- a. Claims 20 and 21 have been cancelled. Claims 15-19 and 22 are pending;
- b. The specification objections have been withdrawn in light of the amendment;
- c. The prior art rejection stands

Specification

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction

Art Unit: 1745

of the following is required: The term "self-supporting" is not explicitly disclosed in the instant application as is now recited in claim 15. The sheet-like tray does not appear to be self-supporting since it appears to require the stiffening element additive so that the tray can maintain sufficient resistance to a load. Thus the flexible silicone-tray material does not appear to have been defined in the original disclosure as being self-supporting and the original specification lacks proper antecedent basis for this subject matter.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 15-19 and 22 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The term "self-supporting" is not explicitly disclosed in the instant application. Applicant subsequently argues that the prior art of record does not teach of silicone, which is "self-supporting." The sheet-like tray is not clearly self-supporting since it appears to require the stiffening element additive so that the tray can maintain sufficient resistance to a load. Thus the flexible silicone-tray material does not appear to have been defined in the original disclosure as being self-supporting.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

Art Unit: 1745

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

7. Claims 15-19 and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. Claim 15 recites the limitation "the type" in line 8. There is insufficient antecedent basis for this limitation in the claim. This also applies to claims 16-19 and 22.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 15-19 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. patent No. 4,045,153 (Maurino), of record and for the reasons of record.

Maurino discloses a flexible mould FM' comprising: a one-piece silicone sheet-like self-supporting tray comprising a bottom wall 8', side walls 2' extending upwardly from the bottom wall 8', each side wall having an upper edge 4 and including a silicone peripheral wing extending outwardly from the upper edge of each of the side walls 2' around the perimeter of the side walls 2', said wing having a peripheral edge, the RTV silicone is held to be a material of the type which has heat resistance and flexibility and resists temperatures equivalent to those temperatures which are generated by ovens for making confectionery and breads, a stiffening element 7 in the form of a wing stiffening

Art Unit: 1745

element fixed to the wing 4 near the peripheral edge of the wing and extending entirely around the wing, the stiffening element being so constructed as to stiffen the mould in order to give the mould the resistance required to carry weight of a product in the mould without being deformed while keeping the flexibility features and in order to make it possible to lift the mould by the wing so that the mould resists deformation under strain caused by contents of the mould (Fig. 2 and col. 3, ll. 1-3, 5, and 23-32 as applied to claim 15).

Note the following with respect to claim 15:

With respect to the tray being "self-supporting" there are two issues with respect to this claim. First that there is no support for this feature as found in the original written description of the instant application. This new matter issue having been addressed above. Second that the manner or degree that the tray is "self-supporting" is not specified or defined by the instant application and in it's broadest sense, the prior art has some degree of definite shape and structure and therefore has a degree of "self-supporting" ability.

With respect to silicone being of the type which has heat resistance and flexibility and resists temperatures equivalent to those temperatures which are generated by ovens for making confectionery and breads. The prior art silicon RTV is a material which has an inherent degree of heat resistance and flexibility. Furthermore the temperature levels are not specified by the instant application and are any temperature levels which are applied to bread or confectionery materials during fabrication of these materials. Thus the RTV material will inherently resist the minimum temperatures

Art Unit: 1745

equivalent to those temperatures which are generated by ovens for making confectionery and breads, absent clear evidence to the contrary.

With respect to the stiffening element being so constructed as to stiffen the mould in order to give the mould the resistance required to carry weight of a product in the mould without being deformed while keeping the flexibility features and in order to make it possible to lift the mould by the wing so that the mould resists deformation under strain caused by contents of the mould. The stiffening element 7 provides a degree of anti-deformation of the mould. Note that neither the claims nor specification define the amount of resistance required or of the weight of the product causing strain on the mould. Thus versus a minute weight of a product causing strain on the mould, the wing will give the mould resistance to deformation.

In short the various parameters for defining the mould, stiffening element and manner in which the two function is extremely broad since the various parameters Applicant relies upon for defining the claims are not specified and can be at any level.

Since the prior art has the same structural configuration as that of claim 15, the prior art is clearly adapted to perform the same function (as applied to claim 15).

The sidewalls 2' diverge outwardly and upwardly from bottom 8' (Fig. 3 as applied to claim 16).

The wing-stiffening element 7 is at least partially encased in the silicone near the peripheral edge of the wing (Figs. 2 and 3 as applied to claim 17).

The restraining member 7 may be comprised of a plastic or metal tube, a solid metal ring or a tightly coiled spring imbedded in the periphery of the flange (col. 3, ll.

Art Unit: 1745

30-32 as applied to claims 18 and 19). A solid metal ring is structurally identical to a metal wire. The instant application fails to define the thickness of the wire or any structural features of the wire which would structurally distinguish it from a metal ring (as applied to claim 19).

The mould has the same claimed shape (having a bottom, sidewalls and a peripheral wing, as discussed above. The RTV silicone in the shape shown by Maurino having the same claimed material and shape of construction is possible to be flattened. Flattening of this flexible silicone material enables it to be stored in a reduced space. The contents of the mould are not accorded patentable weight with respect to the claimed invention, the mould itself, since the contents fail to further limit the mould (as applied to claim 22). See MPEP § 2115.

Response to Arguments

11. Applicant's arguments filed December 17, 2002 have been fully considered but they are not persuasive.

Applicant does not provide clear evidence that the prior art of record cannot provide the claimed functions under conditions such as minute product weight stresses and the lowest temperatures. Therefore it is held that the prior art which teaches of the same claimed structural arrangement, will function in the same manner as the recited in the claims.

While intended use recitations and other types of functional language cannot be entirely disregarded. However, in apparatus, article, and composition claims, intended

Art Unit: 1745

use must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. In re Casey, 370 F.2d 576, 152 USPQ 235 (CCPA 1967); In re Otto, 312 F.2d 937, 938, 136 USPQ 458, 459 (CCPA 1963).

Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. In re Danly, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). See also MPEP § 2114.

The manner of operating the device does not differentiate an apparatus claim from the prior art. A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987).

For the reasons set forth above, the prior art of record is held to anticipate the instant claims.

Response to Exhibits A and B

12. The Examiner has considered Applicant's Exhibits A and B but does not find the evidence therein to overcome the prior art rejection of record.

Art Unit: 1745

13. With respect to Exhibit A: This exhibit is only a generalization as stated in Applicant's response and while this Exhibit generalizes differences between RTV silicone (a material recited by Maurino) versus heat curing silicone rubber, it fails to provide a clear and defining statement that all RTV silicone materials are incapable of being "self-supporting". And such is even less convincing given the fact that the term "self-supporting" is not clearly recited nor defined by the instant application. In addition, the claims do not exclude RTV silicone as the claimed silicone material. Therefore this Exhibit fails to provide clear evidence for overcoming the prior art rejection of record.

14. With respect to Exhibit B: while the trays shown in this exhibit are presented by Applicant to show that the trays are "self-supporting", this is not held to be proper basis for defining the term "self-supporting" since the instant application, as originally filed, makes no statement of such.

Conclusion

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregg Cantelmo whose telephone number is (703) 305-0635. The examiner can normally be reached on Monday through Thursday from 8:00 a.m. to 5:30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Pat Ryan, can be reached on (703) 308-2383. FAX communications should be sent to the appropriate FAX number: (703) 872-9311 for After Final Responses only; (703) 872-9310 for all other responses. FAXES received after 4 p.m. will not be processed until the following business day. Any inquiry of a

Art Unit: 1745

general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Gregg Cantelmo
Patent Examiner
Art Unit 1745

gc



March 9, 2003